## REMARKS

Claims 11, 43, 44 and 25-40 are canceled.

Claims 1, 9, 12, 13, 15-18, 20, 21, 23, 24 and 41 are amended.

Dependant Claims 45-58 are added.

Claims 1-3, 5-9, 12-18, 20-24, 41, 42 and 45-58 remain pending for consideration.

No new matter is added. Support for the Claims may be found at ¶¶ [0031] – [0058] and FIGS. 5-14 of U.S. Publication No. 2005/0074544.

Claims 25-40 were canceled without prejudice or disclaimer. These claims were restricted as being directed to a separate invention. Applicants intend to pursue the subject matter of these claims in a divisional application.

**Claim Rejections 35 U.S.C. § 112**

Claims 42-44 are rejected under 35 U.S.C 112, first paragraph, as failing to comply with the written description requirement. Claims 43 and 44 are canceled without prejudice or disclaimer. Applicants have amended Claim 42. This claim complies with all requirements under Section 112. Withdrawal of the rejection to Claim 42 is earnestly solicited.

**Claim Rejections 35 U.S.C. § 102**

Claims 1, 5, 7-9, 16, 17, 41 and 43 stand rejected under 35 U.S.C. § 102(b) as anticipated by RD 434009, June 2000 (hereinafter "*RD*"). Claims 1, 5, 7-9, 13, 14, 18, 20, 22-24 and 43-44 are rejected under 35 U.S.C. § 102(b) as anticipated by *Castro* et al (6395326). Applicants traverse this rejection for the following reasons.

*RD* discloses a stent on a mandrel which is rolled on a carrier, such as a cloth or sponge (FIG. 1). This reference also shows a stent that is placed on a mandrel and then placed within a cylindrical cup that has an agent soaked cloth or sponge lining the inside of the cup (FIG. 2). *Castro* shows various embodiments of a device in which either a stent is rotated relative to an applicator, or an applicator rotated relative to a stent. the movement allows an applicator head to dispense a coating over a selected area of the stent strut.

Claim 1 is directed to a method of coating a tubular implantable medical device comprising rotating an applicator in a first direction so as to form a layer of a coating composition on a surface of the applicator, and transferring at least some of the layer of the coating composition onto a tubular implantable medical device rotating in a second direction, wherein the second direction is opposite to the first direction or refers to rotation about an axis that is not parallel to a rotation axis of the applicator.

*RD* does not teach or suggest the step of rotating an applicator in a first direction so as to form a layer of a coating composition on a surface of the applicator. *RD* simply states that the stent is coated via an agent soaked cloth or sponge. *Castro* does not teach this step either. *Castro* shows a dispenser that may be moved relative to the stent to deposit a coating. However, there is no teaching or suggestion for rotating an applicator in a first direction so as to form a layer of a coating composition on a surface of the applicator.

Anticipation under 35 U.S.C. § 102 requires that each limitation of a claim is found in a single reference either expressly or inherently. *See Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 77 USPQ2D 1321 (Fed. Cir. 2005). Neither *Castro* nor *RD* teach or suggest the step of rotating an applicator in a first direction so as to form a layer of a coating composition on a surface of an applicator. Accordingly, neither of these references can anticipate Claim 1.

Withdrawal of the rejections of Claim 1 based on *RD* and *Castro*, and allowance of Claim 1 is earnestly solicited.

Claim 9 is directed to a method of coating a tubular implantable medical device, the medical device having a bore, comprising: placing an applicator having an applicator surface containing at least a polymer dissolved in a solvent into the bore; and applying the polymer dissolved in a solvent to the bore.

Neither *RD* nor *Castro* teach or suggest the step of placing an applicator having an applicator surface containing at least a polymer dissolved in a solvent into the bore; and applying the polymer dissolved in a solvent to the bore. Both references are concerned with placing a coating on an external surface of a medical device. However, there is no teaching or

suggestion for the step of placing an applicator having an applicator surface containing at least a polymer dissolved in a solvent into the bore; and applying the polymer dissolved in a solvent to the bore. Accordingly, Claim 9 is not anticipated by *Castro* or *RD*.

Withdrawal of the rejections of Claim 9 based on *RD* and *Castro*, and allowance of Claim 9 is earnestly solicited.

Claim 18 is directed to a method of coating a tubular implantable medical device, comprising: rotating a member so as to form a layer of a coating composition over a surface of an applicator, and transferring at least some of the layer of the coating composition onto a tubular implantable medical device while the member rotates.

For similar reasons as those given above for Claim 1, Claim 18 is also not anticipated by *RD* or *Castro*. Withdrawal of the rejections of Claim 18 based on *RD* and *Castro*, and allowance of Claim 18 is earnestly solicited.

Claim 41 is directed to a method of coating a tubular implantable medical device having an outer surface, whereby a surface portion forms a portion of the outer surface and the surface portion extends along the longitudinal axis of the medical device, the method comprising: submerging the tubular implantable medical device into a coating composition including placing only the surface portion in contact with the coating composition; and rotating the submerged device about the [[a]] longitudinal axis.

FIG. 2 of *RD* depicts a stent being placed in a cup that is lined with a cloth or sponge soaked with an agent. However, nowhere in this reference is there a teaching or suggestion for submerging the tubular implantable medical device into a coating composition including placing only the surface portion in contact with the coating composition, as described in Claim 41. The entire circumference of a stent is in contact with the soaked sponge or cloth in *RD*. Accordingly, Claim 41 is also not anticipated by *RD*.

Withdrawal of the rejections of Claim 9 based on *RD* and *Castro*, and allowance of Claim 9 is earnestly solicited.

Claims 2-3, 5-8, 12-17, 20-24, 42 depend from Claims 1, 9 and 18 and recite(s) additional features that further distinguish Applicants' invention over the art of record. However, it is not necessary to point out the additional features recited in these dependant claims. Because Claims 2-3, 5-8, 12-17, 20-24, 42 depend from allowable claims, they are also allowable. For this reason, Applicants ask that all standing rejections of Claims 2-3, 5-8, 12-17, 20-24, 42 under 35 U.S.C. §§ 102 and 103, respectively, be withdrawn.

In view of the foregoing claims and accompanying remarks Applicants respectfully ask that all pending claims be indicated as allowable.

**CONCLUSION**

In light of the foregoing claim amendments and remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Respectfully submitted,

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Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza
Suite 300
San Francisco, CA 94111
Facsimile (415) 393-9887
Telephone (415) 954-0314

James L. Reed
Reg. No. 43,877
Attorney for Applicants